

RESPONSE under 37 C.F.R. § 1.116  
U.S. Appl. No. 09/595,557

**REMARKS**

Claims 2-6, 12-20, 22, and 24-29 are all the claims pending in the present application. Claims 2-6, 12-20, 22 and 24-25 stand rejected and claims 26-29 are subject to a restriction requirement. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

**RESTRICTION.**

Claims 26-29 are subject to a restriction requirement and have been indicated as withdrawn from consideration by the Examiner. Applicant respectfully traverses the restriction requirement electing claims 2-6, 12-20, 22 and 24-25.

Every requirement for restriction has two criteria: (i) the inventions must be independent or distinct as claimed; and (ii) there must be a serious burden on the examiner to examine all the claims in the application in order to properly restrict claims. MPEP 803. The particular reason relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. "A mere statement of conclusion is inadequate." MPEP 816.

In the instant case, the Office Action provides no reasoning whatsoever, how claims 26-29 are considered to be independent or distinct from the invention in the originally filed claims nor how examining such claims would be a serious burden on the examiner. Thus, neither of the criteria required for every restriction requirement have been met and Applicant respectfully requests reconsideration. Based on the conclusory statement referring to MPEP 821.03 provided in the Office Action, it appears that it is being alleged it would never be proper to add new independent claims in an application, which is clearly in contrast to the provisions of 37 C.F.R. § 1.121 and 37 C.F.R. § 1.173.

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Should the Examiner disagree with the Applicant and maintain the Restriction Requirement, Applicant respectfully requests the Examiner to clarify "the reasons upon which the conclusion is based" that claim 26 is related to an independent or distinct invention from that that defined in, for example, existing claim 12. Absent this showing, the restriction requirement is improper and should be withdrawn and such action is respectfully solicited.

Lastly, Applicant notes that claims 26-29 were presented by Applicant's amendment filed on July 22, 2004. Accordingly, regardless of whether these claims are withdrawn from consideration due to the instant restriction requirement, it is believed they should still be indicated as pending in the application in contrast to the indication in Office Action summary.

#### **REISSUE APPLICATIONS.**

##### **Surrender of Original Patent**

The Office Action continues to take note that the original patent or statement of inaccessibility or loss of the original patent must be received before this application can be allowed. Applicant will either submit the original patent or statement of loss upon the indication that the claims include allowable subject matter.

##### **Declaration**

The Office Action continues to indicate that a supplemental declaration is required before the application can be allowed and all of the pending claims are rejected under 37 C.F.R. §1.175(b)(1). The apparent alleged deficiency is that Applicant has not declared that errors which are corrected by the reissue application arose without deceptive intent.

However, Applicant once again submits that it believes this statement is indisputably present in the original reissue declaration submitted on June 14, 2000 (see first paragraph page 2). A copy of the original reissue declaration (which was prepared and originally filed using the

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USPTO's own authorized form) is attached to this response as it appears the same objection to the reissue declaration is being continually and needlessly asserted. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 2-6, 12-20, 22 and 24-25 under 35 U.S.C. § 251 and the objection to the reissue declaration or explain with greater particularity the alleged defects of the original reissue declaration.

**35 U.S.C. § 103**

Claims 2-6 are finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhang et al. "Comparisons of Channel-Assignment Strategies in Cellular Mobile Telephone Systems" (IEEE, November 1998) (hereinafter "Zhang") in view of U.S. 5,355,367 to Comroe et al. (hereinafter "Comroe"). The Office Action alleges that Zhang discloses all of the limitations in these claims with the exception of the Time Division Duplex (TDD) or Time Division Multiple Access (TDMA) limitations in claims 2-6. The Office Action relies on Comroe to make up for these deficiencies of Zhang alleging, it would have been obvious to the one of ordinary skill in the art to modify Zhang with the TDMA system of Comroe "in order to improve capacity of the [Zhang] communication system." (1/26/06 Final Office Action pg. 4). Applicant respectfully traverses this rejection for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

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Zhang discloses channel assignment strategies for use in a frequency division multiple access (FDMA) cellular mobile telephone system using the frequency band allocated by the FCC having 832 duplex frequency channels for transmissions between mobile stations and base stations. (Zhang, pg. 211, sec. I). There are several techniques (fixed assignment (FA), simple borrowing (SB), hybrid assignment (HA), borrowing with Channel Ordering (BCO) and borrowing with directional channel locking) discussed by Zhang to increase the amount of potential calls a base station in a multi-cell network can handle at one moment if necessary. Zhang discloses that to satisfy the large demand of mobile telephone service, the frequency division duplex channels need to be reused in different non-interfering cells and proposes various ways of allocating channels amongst a plurality of cells to reduce blocked calls. Accordingly, Zhang is dedicated to techniques for increasing the number of FDMA channels that a base station might need to support calls without interfering with the frequencies being used by adjacent cells.

By way of contrast, Comroe discloses a communication system in which a one cell re-use pattern of communication resources may be used in the communication system. Comroe discloses that each base station may be sectorized so that each adjacent cell may use the same channel resources, but that adjacent sectors between two neighboring cells use different frequency resources to reduce signal-to-noise and interference ratios. (Fig. 1, col. 3, ll. 27-34; and col. 2, ll. 1-5). Comroe discloses that time division multiplexing (TDM) may be used in its system to improve call capacity of the communication system by splitting digital frames of the same frequency channel amongst multiple callers (col. 1, ll. 51-58). However, there does not appear to be any teaching or suggestion by Comroe that TDM can be combined with multi-cell pattern FDMA systems (where every transmission in a cell uses different frequency channel), such as that disclosed by Zhang.

In fact, Applicant respectfully submits that the use of sectorized base stations using TDM disclosed by Comroe could render the shortage of frequency channels in an FDMA system,

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which the Zhang methods are devoted to addressing, entirely moot. Accordingly, the proposed modification of Zhang with the TDM techniques of Comroe appears to render to primary reference (Zhang) unsuitable for its intended purpose, namely increasing the number of available FDMA channels a base station can use without blocking calls. Further, Comroe teaches away from Zhang by explicitly teaching allocating frequency resources in a one cell re-use sectorized pattern while Zhang discloses multi-cell non-sectorized frequency re-use patterns.

In any event, because Zhang makes no mention of using TDM and because there is no suggestion by Comroe that TDM could or should be used in FDMA systems such as Zhang, the combination of these references as proposed in the Office Action appears to be based solely on a hindsight attempt to reconstruct Applicant's claims rather than based on actual motivation disclosed in the references or known to those skilled in the art. Because there does not appear to be proper motivation to combine Zhang and Comroe as proposed in the Office Action, Applicant respectfully submits *prima facie* obviousness has not been established and requests the Examiner to reconsider and withdraw the §103 rejection of claims 2-6.

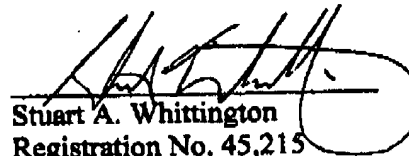
#### **CONCLUSION.**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to Deposit Account # 50-0221.

Respectfully submitted,

  
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Date: April 26, 2006

PTO/SB/51 (12-87)

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## REISSUE APPLICATION DECLARATION BY THE INVENTOR

Docket Number (Optional)

226/132

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in patent number 5,850,600, granted 12/15/98, and for which a reissue patent is sought on the invention entitled Three Cell Wireless Communication System

the specification of which

☒ is attached hereto.

☐ was filed on \_\_\_\_\_ as reissue application number \_\_\_\_ / \_\_\_\_\_  
and was amended on \_\_\_\_\_  
(If applicable)

I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all boxes that apply.)

☐ by reason of a defective specification or drawing.☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.☐ by reason of other errors.

At least one error upon which reissue is based is described as follows:

The attorney failed to appreciate the full scope of the invention and unduly restricted the invention by requiring that base stations in adjacent cells must each be assigned different frequencies for communication, and that user stations within adjacent cells have to also be assigned different frequencies for communication. The possibility of this error was first discovered after payment of the issue fee, but the attorney did not fully appreciate the proper scope of the invention until after conducting an investigation which was not completed until after the patent issued.

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Docket No. 226/132  
June 14, 2000

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## (REISSUE APPLICATION DECLARATION BY THE INVENTOR, page 2)

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All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant. As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith.

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

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☐ Additional joint inventors are named on separately numbered sheets attached hereto.

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